



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/557,193	11/17/2005	Hiroyuki Kikkoji	277511US6PCT	5502
22850	7590	11/12/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER SIKRI, ANISH	
			ART UNIT 2443	PAPER NUMBER
			NOTIFICATION DATE 11/12/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/557,193	Applicant(s) KIKKOJI ET AL.	
	Examiner ANISH SIKRI	Art Unit 2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/24/09 6/12/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement submitted on 2/24/09, 6/12/09 been considered by the Examiner and made of record in the application file.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11, 14 of the claimed invention are rejected under 35 USC 101 and are directed to non-statutory subject matter. The claims are directed to a computer readable medium, which is broad enough to be interpreted as a signal. The applicant can overcome 101 rejections by amending to "non-transitory computer readable medium". Examiner also advises the client to amend the specific so that it reflects the new claimed terminology and it will help in avoiding lack of antecedent basis problem in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

Art Unit: 2443

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.

Ascertaining the differences between the prior art and the claims at issue.

Resolving the level of ordinary skill in the pertinent art.

Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. **Claims 1-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibasaski et al (US Pub 2004/0167856), hereafter Shibasaki, in view of Kinebuchi et al (US Pub 2003/0074448), hereafter Kinebuchi.

2. Consider **Claim 1**, Shibasaki disclosed information-recording apparatus characterized by comprising (Shibasaski, [0007], Shibasaki disclosed that it is a information-recording apparatus): receiving means for receiving a plurality of information related to of contents broadcast (Shibasaski, [0088], Shibasaki disclosed on how information can be acquired from the network, and recorded in the apparatus); temporary storage means for temporarily storing the plurality of information items related to the contents (Shibasaski, [0074], Shibasaki disclosed on how information is retained in the temporary storage); storage means for storing pluarality of information related to contents (Shibasaski, [0074]); instructing means for instructing that the plurality information items temporarily stored in the temporary storage means be recorded in the storage means (Shibasaski, [0074]), recording means for recording at least one of the plurality the related information contents stored in the temporary storage means (Shibasaski, [0074], [0076], Shibasaki disclosed on how the information is encoded in the temporary storage before being processed or transferred to a different location/device) ,

3. But Shibasaki does not explicitly state the use of a set, and the name of a set in association with the set and displaying means for displaying the name of the set.

Art Unit: 2443

4. Nonetheless, Kinebuchi disclosed the use and the name of the set, and displaying the name of the set (Kinebuchi, [0066], [0078], [0091]), Kinebuchi disclosed that the information can be formed by groups containing relevant information specific to the group/set), and the name of a set in association with the set (Kinebuchi, [0097], Kinebuchi disclosed that the groups are independent to other groups, as that implies that the groups are named/marked independently from each other), in the storage means, in response to an instruction made by the instructing means (Kinebuchi, [0078], [0091] Kinebuchi disclosed that the information contained in groups/sets are stored in the memory)

5. Both Shibasaski and Kinebuchi provide features related to information recording. Therefore one of ordinary skill in the art would have been motivated to combine the teachings since both are within the same environment.

6. Therefore, it would have been obvious to a person skilled in the art at the time of the invention was made to incorporate the use of groups/sets to contain information taught by Kinebuchi, in the system of Shibasaski for the purpose of management of resources in information-recording system of Shibasaski.

7. **Claim 2**, has similar limitations as Claim 1, therefore it is rejected under the same rational as Claim 1.

8. Claim 2, The information-recording apparatus according to claim 1, wherein the plurality of the information related to the contents includes information on a program

Art Unit: 2443

broadcast (Shibasaski, [0007]), and the recording means records the information related to the contents having a common program broadcast as a set of information on contents in storage means (Shibasaski, [0074], Shibasaski disclosed on how information is retained in the temporary storage), when the instructing means instructs that the information related to the contents of the common program broadcast be recorded in the storage means (Shibasaski, [0074], [0076], Shibasaski disclosed on how the information is encoded in the temporary storage before being processed or transferred to a different location/device), and records the name of the program broadcast as the name of the set (Kinebuchi, [0078], [0091] Kinebuchi disclosed on how the name of the set is displayed).

9. Consider **Claim 3**, Shibasaski-Kinebuchi disclosed information-recording apparatus according to claim 2, wherein the records the information (Shibasaski, [0007], Shibasaski disclosed that it is a information-recording apparatus) related to the contents of the common broadcast during a given time period (Kinebuchi, [0066], Kinebuchi disclosed that process of acquiring content can set to certain desired time period), as a set of information on contents (Kinebuchi, [0066], [0097], Kinebuchi disclosed that the information contained in groups/sets are stored in the memory), in the storage means when the instructing means instructs that the information related to the contents of the common program broadcast in the given time period be recorded in the storage means (Kinebuchi, [0078], [0091]), and records the name of the common broadcast program and the given time period as the name of the set (Kinebuchi, [0066], [0078], [0091],

Art Unit: 2443

[0097], Kinebuchi disclosed that the groups are independent to other groups, as that implies that the groups are named/marked independently from each other).

10. **Claim 4**, has similar limitations as Claim 1, therefore it is rejected under the same rational as Claim 1.

11. **Claim 5**, has similar limitations as Claim 1, therefore it is rejected under the same rational as Claim 1.

12. Consider **Claim 6**, Shibasaki-Kinebuchi disclosed information-recording apparatus according to claim 1, further comprising reproducing means for reproducing the contents from a recording medium (Shibasaki, [0007]), and transmitting means for transmitting request information requesting for the information related to the contents reproduced by the reproducing means (Shibasaki, [0007], [0009], Shibasaki disclosed on information is acquired and reproduced), wherein the receiving means receives a plurality of information related to the contents corresponding to the request information (Shibasaki, [0031], [0038], Shibasaki disclosed on how the related information such as trail-listening information is acquired), the recording means records the information related to the contents items received by the receiving means (Shibasaki, [0031], [0038]), as the set, records a name of the set that is linked to the set, in the storage means (Kinebuchi, [0066], [0078], [0091], [0097], Kinebuchi disclosed that the

Art Unit: 2443

information can be formed by groups containing relevant information specific to the group/set).

13. **Claim 7**, has similar limitations as Claim 1, therefore it is rejected under the same rationale as Claim 1.

14. Consider **Claim 8**, Shibasaki-Kinebuchi disclosed information-recording information (Shibasaki, [0007], Shibasaki disclosed that it is a information-recording apparatus) method according to claim 7, wherein the step of receiving information related to the contents (Shibasaki, [0031], [0038], Shibasaki disclosed on how the related information such as trail-listening information is acquired) is performed as a terminal apparatus that communicates with an authentication server having an authentication function and a related-information providing server for providing the information related to the contents, wherein the step of receiving includes steps of (Kinebuchi, [0040], [0078], Kinebuchi disclosed on how the authentication is carried out and which results in retrieving information from the server and vice-versa): transmitting request information requesting for the information related to the contents (Shibasaki, [0031], [0038], Shibasaki disclosed on how the related information such as trail-listening information is acquired), to the related-information providing server, together with a service-session ID that identifies a session between the terminal apparatus and the related-information providing server (Kinebuchi, [0202], Kinebuchi disclosed that the

Art Unit: 2443

after the user authentication process is carried out which involves the use of member number/id and password, the system carries out the session control, which involves a special process which helps in maintaining of the session); receiving, from the related-information providing server, information representing an authentication error and service identification information identifying the related-information providing server (Kinebuchi, [0202], [0227], discloses on how the authentication error process is carried out); transmitting authentication-ticket request information to the authentication server (Kinebuchi, [0202], Kinebuchi disclosed that the authentication is carried out after the user validates his/her user id and password successfully), together with the authentication-session ID that identifies a session between the terminal apparatus and the authentication server (Kinebuchi, [0202], Kinebuchi disclosed that the authentication session is kept alive, after the user has successfully authenticated himself/herself, and even if the process abruptly terminated, the authentication process creates a special process which involves creating a special file called the "client agent file" (Kinebuchi, [0234]), which allows the transmission to resume itself again) , the authentication-ticket request information requesting that an authentication ticket be issued for an access to the related-information providing server (Kinebuchi, [0202], [0234] Kinebuchi disclosed the special process and "client agent file" which is created after and during the successful authentication of the user); receiving the authentication ticket issued by the authentication server when the authentication server authenticates the terminal apparatus (Kinebuchi, [0234], Kinebuchi aids in the creation and use of the "client agent file" which aids in authentication), and transmitting the authentication-ticket request

Art Unit: 2443

information (Kinebuchi, [0234]), together with the authentication ticket to the related-information providing server; receiving the service-session ID, when the related-information providing server authenticates the terminal apparatus (Kinebuchi, [0202], [0234]); transmitting request information for requesting the related information to the related-information providing server (Kinebuchi, [0202], [0234]), together with the service-session ID; and receiving the information corresponding to the request information (Kinebuchi, [0202], [0234]), when the related-information providing server authenticates the terminal apparatus (Kinebuchi, [0202], [0234]).

15. **Claim 9**, has similar limitations as Claim 8, therefore it is rejected under the same rational as Claim 8.

16. Consider **Claim 10**, Shibasaki-Kinebuchi disclosed the information-recording method according to claim 7, further comprising the steps of transmitting, at predetermined intervals (Kinebuchi, [0066], Kinebuchi disclosed that process of acquiring content can set to certain desired time period), request information requesting the information related to the contents being broadcast and received, displaying the information related to the contents (Shibasaki, [0031], [0038], Shibasaki disclosed on how the related information such as trail-listening information is acquired), wherein the information related to the contents that corresponds to the request to the request information is received in the said step of receiving (Shibasaki, [0031], [0038]), and wherein the information related to the contents received is displayed in the step of

Art Unit: 2443

displaying (Kinebuchi, [0078], [0091] Kinebuchi disclosed on how the name of the set is displayed).

17. **Claim 11**, has similar limitations as Claim 1, therefore it is rejected under the same rational as Claim 1.

18. Consider **Claim 12**, Shibasaki-Kinebuchi discloses the information-recording apparatus according to Claim 1, wherein the displaying means is further displaying said information related to the contents in a list, together with the name of the set (Kinebuchi, [0078], [0091] Kinebuchi disclosed on how the name of the set is displayed).

19. Consider **Claim 13**, Shibasaki-Kinebuchi discloses the the information-recording method according to Claim 7, wherein said step of displaying further displays said information related to the contents in a list, together with the name of the set (Kinebuchi, [0078], [0091] Kinebuchi disclosed on how the name of the set is displayed).

20. Consider **Claim 14**, Shibasaki-Kinebuchi discloses the computer readable medium Shibasaki, [0007], Shibasaki disclosed that it is a information-recording apparatus) according to Claim 11, wherein said step of displaying further displays said information related to the contents in a list, together with the name of the set (Kinebuchi, [0078], [0091] Kinebuchi disclosed on how the name of the set is displayed).

Response to Arguments

Applicant's arguments filed 4/20/09 have been fully considered but they are not persuasive.

Applicant argues For Claim 1, 7, and 11, that in the combination of references Shibasaki-Kinebuchi, that Kinebuchi does not teach that the set of information on the contents is linked to a name of the set, and that a displaying means displays the name of the set. Examiner cites the reference Kinebuchi does indeed teach that the set of information on contents is linked to a name of the set, and that a displaying means display the name of the set (Kinebuchi, [0066], Kinebuchi discloses that the contents are formed by groups thus creating a set, and each group/set can be independent from each other and provided on a channel by channel basis, thus allowing the system to create sets. Kinebuchi discloses in [0078], [0091], on how channel are displayed on the screen, thus it allows the user to see the channel and which group/set name it comprises off).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2443

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH SIKRI whose telephone number is 571-270-1783. The examiner can normally be reached on 8am - 5pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anish Sikri

Application/Control Number: 10/557,193

Page 14

Art Unit: 2443

a.s.

Oct 26, 2009

/Tonia LM Dollinger/

Supervisory Patent Examiner, Art Unit 2443